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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/018,316   | 08/05/2003  | Derek Whitaker       | 0091-0207P          | 1645             |
| 2292   | 7590        | 06/01/2004           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | BASINGER, SHERMAN D |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3617                |                  |
| DATE MAILED: 06/01/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                     |                 |
|------------------------------|---------------------|-----------------|
| <b>Office Action Summary</b> | Application No.     | Applicant(s)    |
|                              | 10/018,316          | WHITAKER ET AL. |
|                              | Examiner            | Art Unit        |
|                              | Sherman D. Basinger | 3617            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/18/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because figure 5 does not comply with 37 C.F.R. 1.84(u)(1).
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference numerals 12 and 13 of page 8 of the specification are not in the drawings.

## INFORMATION ON HOW TO EFFECT DRAWING CHANGES

### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

### ***Specification***

3. Subtitles similar to those set forth in 37 C.F.R. 1.77 should be used throughout the specification.
4. On page 2 of the specification, line 7, -to- should be inserted after "can be made".
5. On page 4 of the specification, line 24, "wool" should be changed to -wood-.
6. On page 5 of the specification, line 17, "e" is incorrect as figure 5e does not illustrate interconnection of the planks and the caulking strips by means of male and female connection means.
7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: antecedent basis for what is claimed in claims 5, 6, 7, 9 and 16 should be inserted into the specification.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 1, the phrase "for instance" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

11. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "is made by sanding", and the claim also recites "especially using the curved or roller part of a sanding belt" which is the narrower statement of the range/limitation.

12. Regarding claim 5, the phrase "like PVC" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like

PVC"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

13. Regarding claim 7, the phrase "coverings of many other types of surface recipients" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "coverings of many other types of surface recipients"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

14. Regarding claim 8, the phrase "etc." renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "etc."), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

15. Claim 14 recites the limitation "the caulking strips" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-4, 6, 7, 8, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zwigmeyer in view of Anstadt.

Zwigmeyer discloses surface coverings planks 2 interconnected aside of each other as is shown in 1 and which are of a material which is flexible such that planks 2 can be laid in curved formations (see column 3, lines 55-end). The planks of Zwigmeyer are not

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roughened at the upper surface of the covering so as to imitate any unique grain effect of wooden material.

Anstadt discloses imitation wood work pieces roughened on at the upper surface (see column 3, lines 1-6) so as to imitate any unique grain effect of wooden material.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to roughen the planks 2 of Zwigmeyer in a manner similar to that taught by Anstadt to give the planks a wood grain look. Motivation to do so would be to make the boat being manufactured in figure 3 of Zwigmeyer look like a boat made from wood.

With regard to claim 2, Anstadt teaches the use of sanding in column 4, lines 27-30.

Thus, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use sanding to create the wood gain look on the boards 2 of Zwigmeyer. To sand the boards of Zwigmeyer to create the desired wood gain look by sanding in the longitudinal direction of sanding only discrete sanding portions extending at an oblique angle to the longitudinal direction of the plank would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Motivation to do so is to create a particular type of wood grain look which is pleasing to the eye of the person creating the wood grain look.

With regard to claim 6, note column 4, lines 43-end of Anstadt. Thus, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains in view of what is taught by Anstadt to form the

planks of Zwigmeyer with streaks or lines of color included in the extrusion to further imitate the grain in wood. Motivation to do so is to produce a look closer to the desired wood grain.

With regard to claim 7, note the number of uses for the planks 2 of Zwigmeyer. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use the planks of Zwigmeyer in view of what is disclosed in column 1, lines 8-13 for all of the uses set forth in claim 7.

Motivation to do so is to make each of these structures using a plank that is easily manufactured by extrusion.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the planks 2 of Zwigmeyer look like oak wood grain in view of column 4, lines 20-25 of Anstadt.

Motivation to do so is to have the boat being made with the planks look like it is made of oak.

As shown in figure 1 of Zwigmeyer the planks have matching male and female means at opposite longitudinal edges for interconnecting the same.

The rigid material filling the planks of Zwigmeyer is foam 4 (see column 2, line 57). Foam 4 of Zwigmeyer is also the light weight foam material filling planks 2 from the underside-see figure 1.

18. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zwigmeyer and Anstadt as applied to claim 1 above, and further in view of Hunter et al. The planks of Zwigmeyer are made of PVC which includes glass fiber reinforcement.

Zwilgmeyer does not disclose adding additives for UV protection and fire retardance.

UV protection is added to the workpieces of Anstadt as a lacquer. Hunter adds flame retardants, thermal stabilizers, lubricants, plasticizers, pigments, fillers and other commonly available additive material in fabricating his panels (see column 5, lines 15-20).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains in view of the teachings of Anstadt and Hunter et al to add as additives to the material used in making the planks of Zwilgmeyer both fire retardants and UV protection. Motivation to do so is to create a plank that is both weather and fire resistant.

***Allowable Subject Matter***

19. Claims 9-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harshberger is cited to show the surface covering with valleys simulating wood grain. Klammt is cited to show grooved flat bottoms 20. Hinds et al is cited to show the wood simulating siding units.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sherman D. Basinger  
Primary Examiner  
Art Unit 3617

5/19/04

Sdb  
5/19/04